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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,777	02/20/2002	Shigeki Matsuda	111995	3646

25944 7590 07/12/2006

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EXAMINER	
WONG, EDNA	
ART UNIT	**PAPER NUMBER**
1753	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/077,777	MATSUDA ET AL.	
	Examiner	Art Unit	
	Edna Wong	1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This is in response to the Amendment dated May 25, 2006. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Rejections - 35 USC § 112

I. Claims **1-15** have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- With regards to claim 1, lines 13-14, the rejection under 35 U.S.C. 112, first paragraph, has been withdrawn in view of Applicants' amendment.

- With regards to claim 1, line 17, the rejection under 35 U.S.C. 112, first paragraph, is as applied in the Office Action dated November 29, 2005 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that use of the ORP as a measure to monitor the treatment bath is disclosed at least at page 10, lines 13-18 of the specification, as well as in original claim 15.

Claim 1

line 17, recites "and is used to monitor *treatment of the bath*".

Applicants' specification recites:

"Moreover, according to a twelfth mode of the present invention, it is preferable to maintain the above treatment bath in a constant state by measuring the above ORP value of the treatment bath and *changing the amount and/or composition of replenishing chemical corresponding to the change in that value*" (page 10, lines 13-18).

(a) Applicants' specification never disclosed that "changing the amount and/or composition of replenishing chemical corresponding to the change in that value" is the *treatment of the bath*.

The "treatment of the bath" as recited in claim 1, line 17, is open to anything, *including the heating or cooling of the bath*.

It is well settled that unpatented claims are given the broadest, most reasonable interpretation and that limitations are not read into the claims without a proper claim basis therefor. *In re Prater* 415 F. 2d 1393, 162 USPQ 541 (CCPA 1969); *In re Zeltz* 893 F. 2d 319, 13 USPQ 1320.

(b) Claim 1 does not recite any method step of treating the bath.

If there is no method step of treating the bath, then how can the treatment of the bath be monitored using the maintained ORP?

Claim 1 does not recite any treatment of the bath. The only treatment recited in claim 1 is "a metal material *article to be treated*" (claim 1, line 3) and "performing the electrolytic *treatment on said article*" (claim 1, lines 5-14). There is no treatment of the bath, only of the article, as recited in claim 1.

(c) Is claim 15 further limiting the "treatment of the bath" as recited in claim 1, line 17?

The claim limitation of "changing an amount and/or composition of replenishing chemical corresponding to the change in that value" (claim 15, lines 3-5) appears to be further limiting the treatment of the bath as recited in claim 1, line 17, (See Applicants' specification, page 10, lines 13-18).

If it is not, then what is the relationship between changing an amount and/or composition of replenishing chemical corresponding to the change in that value (from claim 15, lines 3-5) and the treatment of the bath (from claim 1, line 17)?

Since claim 1 is missing a method step of treating the bath, claim 15 should be incorporated into claim 1, and then claim 1 would be limiting in scope to changing an amount and/or composition of replenishing chemical, which is the treatment of the bath as supported by Applicants' specification (page 10, lines 13-18).

Or should the claim limitation of "treatment ***of the*** bath" be the claim limitation of -- the ***treatment bath*** --?

II. Claims **1-15** have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

• With regards to claims 8 and 9, the rejection under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicants' amendment.

• With regards to claim 1, the rejection under 35 U.S.C. 112, second paragraph, is as applied in the Office Action dated November 29, 2005 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that as claim 1 recites monitoring the ***treatment bath*** through the use of the ORP, no further method step is required as the method of monitoring is not being claimed.

In response, claim 1, line 17, recites "treatment ***of the*** bath". The only treatment recited in claim 1 is "a metal material *article to be treated*" (claim 1, line 3) and "performing the electrolytic *treatment on said article*" (claim 1, lines 5-14). There is no treatment of the bath, only of the article, as recited in claim 1.

If there is no method step of treating the bath, how can the treatment of the bath be monitored using the maintained ORP?

Should the claim limitation of "treatment ***of the*** bath" be the claim limitation of -- the ***treatment bath*** --?

Claim Rejections - 35 USC § 103

Claims **1-15** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Matsuda** (US Patent No. 5,645,706).

The rejection of claims 1-15 under 35 U.S.C. 103(a) as being unpatentable over Matsuda is as applied in the Office Actions dated January 15, 2004, August 24, 2004, May 9, 2005 and November 29, 2005 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that Applicant disagrees with the supposition because the applied reference fails to disclose or suggest such an interpretation. The dissolution of the material to be treated by anodizing would suggest to one of ordinary skill in the art that the component would be unavoidable. As the material to be treated is not necessarily a component of the film, the allegation that Matsuda suggests the claimed feature is inaccurate.

In response, Matsuda teaches that the phosphate chemical treatment methods may be considered as comprising a step of an etching reaction on *a steel material* and a step of a coat-forming reaction to form a coating (col. 2, lines 54-59). An *anode reaction* involving the dissolution of metal (etching) (Chemical Equation 3) and the forming of the coating (Chemical Equation 4) are:

$$Fe \rightarrow \underline{\mathbf{Fe^{2+}}} + 2e \rightarrow \triangle H \qquad \text{[Chemical Equation 3]}$$

$$3(Zn^{2+}, \underline{\mathbf{Fe^{2+}}}) + 2H_2PO_4^- \rightarrow (Zn, Fe)_3(PO_4) + 4H^+ \qquad \text{[Chemical Equation 4]}$$

(col. 2, line 65 to col. 3, line 5).

The dissolution of metal is a metal of Zn or Fe. These metals would have been a component of the film (Chemical Equation 4). Present claim 3, line 3, recites "an Fe electrode", and claim 4, lines 2 and 5, recites "a steel material" and "an Fe electrode", respectively. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195).

$M \rightarrow M^{n+} + ne$ [Chemical Equation 8] is only when the metal material used is *a non-iron metal* such as aluminum, copper, or the like (col. 3,lines 38-43).

Applicants state that the allegation that the pending claims are rendered obvious by Matsuda improperly relies on the benefit of hindsight to come to a determination of obviousness in light of the applied reference.

In response, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Response to Amendment

Claim Objections

Claim **2** is objected to because of the following informalities:

Claim 2

line 3, the word "the" (third occurrence) should be amended the word -- a --.

There is no "*the* complex with the phosphoric acid". See claim 1, line 8.

Appropriate correction is required.

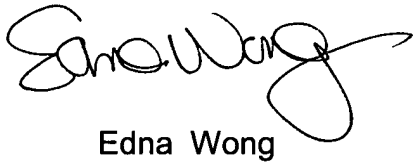
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Edna Wong
Primary Examiner
Art Unit 1753

EW
July 8, 2006